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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/952,995	03/26/1998	MATS LEIJON	70560-2/8242	3266
25269	7590	03/03/2004	EXAMINER	
DYKEMA GOSSETT PLLC FRANKLIN SQUARE, THIRD FLOOR WEST 1300 I STREET, NW WASHINGTON, DC 20005			MULLINS, BURTON S	
			ART UNIT	PAPER NUMBER
			2834	

DATE MAILED: 03/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 08/952,995	<b>Applicant(s)</b> LEIJON ET AL.	
	<b>Examiner</b> Burton S. Mullins	<b>Art Unit</b> 2834	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 January 2004 (after final amendment).
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-4,6,8-10,14-22,26,27,29,30,33,35-39 and 41-44 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,8-10,19,26,27,29,33,35-39 and 42-44 is/are rejected.
- 7) ☒ Claim(s) 2,6,14-18,20-22,30 and 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment under 37 CFR 1.116 filed January 13, 2004 has been entered. However, in light of new grounds of rejection, finality of the previous action is withdrawn.

### ***Claim Rejections - 35 USC § 112***

2. Claims 26-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 27 is a duplicate of claim 2. Further, both claims 26 and 27 recite "A motor as claimed in claim 1". However, claim 1 recites "an electrical plant...including one or more motors...." Thus, it is not clear which motor claims 26 and 27 refer to, or if the claims' language refers to the electrical plant of claim 1.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1, 3-4, 8-9, 10, 19, 29, 33, 35-39 and 42-44 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 61 and 63-70 of copending Application No. 10/603,802. This is a provisional obviousness-type double patenting rejection.

Claims 1, 29 and 43-44 of the current application are drawn to an electric plant for high voltage including one or more motors each comprising at least one winding, wherein the winding of at least one of the electric motors forms at least one complete uninterrupted turn, said winding comprising an electrical conductor including a plurality of insulated conductive elements and at least one uninsulated conductive element and an electric field confining insulation system including an inner semiconducting layer, surrounding and being in electrical contact with the at least one uninsulated conductive element: a solid insulation layer surrounding the inner layer and an outer semiconducting layer surrounding the insulation layer, each semiconducting layer forming an equipotential surface around the conductor.

Claim 61 of the '802 application recites "a rotating high-voltage rotating electric machine, comprising: a stator; a rotor opposing said stator; and a flexible high-voltage stator winding including at least one current-carrying conductor, an electric field confining cover surrounding the current-carrying conductor including an inner layer surrounding and in electrical contact with the current-carrying conductor, an insulating layer surrounding and in contact with the inner layer, and an outermost layer surrounding and in contact with the insulating layer, said outermost layer having a conductivity for establishing an equipotential surface around the current carrying conductor, said current carrying conductor comprises a

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plurality of conductive elements, selected ones of said plurality of conductive elements being insulated from each other, and at least one of said plurality of conductive elements being uninsulated in order to electrically contact the inner layer, wherein said high-voltage winding is configured to form at least a full uninterrupted turn in the winding of said machine” while claim 63 adds that “the inner and outermost layers have semiconducting properties”.

The only difference between the present application and claims 61/63 of the ‘802 application is that the present application recites “an electrical plant for high voltage including one or more motors...” (or “at least one motor”).

However, this feature would have been inherent in the claims of the ‘802 application since a rotating high-voltage electrical machine constitutes an “electrical plant” in the sense that the machine itself is the essential element of the plant, and the motor (or motors) claimed in the current application are a species of the generic “rotating high-voltage rotating electric machine” of the ‘802 application.

Regarding claim 3 of the current application, see claim 65 of the ‘802 application.

Regarding claim 4, transformation of substantial power is inherent in the “high-voltage” winding of the ‘802 application.

Regarding claims 8-9, this is inherent in the device of claims 61/63 of the ‘802 application.

Regarding claim 10, see claim 65 of the ‘802 application.

Regarding claim 19, reactive power is inherently produced by the machine of claims 61/63 of the ‘802 application. Further, claim 66 states that the machine is operable at 100% overload for two hours.

Regarding claim 29, note that claim 70 recites a cable.

Regarding claim 33, note claim 64.

Regarding claim 35, see claim 65 of the '802 application.

Regarding claim 36, see claim 66 of the '802 application.

Regarding claim 37, see claim 67 of the '802 application. The equipotential surface of the conductors inherently eliminates the electric field outside of the cable.

Regarding claim 38, see claim 68 of the '802 application.

Regarding claim 39, see claim 69 of the '802 application.

Regarding claim 42, operation at greater than 36kV is inherent in the "high-voltage" machine of the '802 application.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Burton S. Mullins whose telephone number is 571-272-2029. The examiner can normally be reached on Monday-Friday, 9 am to 5 pm. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Burton S. Mullins  
Primary Examiner  
Art Unit 2834

bsm  
19 February 2004